

Attorney Docket No.: ISPH-0623
Inventors: Karras and Condon
Serial No.: 10/033,742
Filing Date: December 28, 2001
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REMARKS

Claims 1, 2, 4-10 and 12-14 are pending in the instant application. Claims 1, 2 and 12-14 have been rejected. Claims 4-8 and 10 have been objected to. Claims 2 and 4 have been canceled. Claims 1, 5, 6, 8 and 10 have been amended. Applicants' respectfully point out that claim 9, which has not been rejected in the pending Office Action should also be included in the list of claims that have been objected to. Accordingly, Applicants have assumed that claim 9 is objected to in their response to this Office Action. No new matter has been added by these amendments of the claims. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner suggests that claim 1 recites the limitation "said antisense oligonucleotide" but that there is insufficient antecedent basis for this limitation. Applicants have

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amended claim 1 to correct the antecedent basis. Withdrawal of this rejection is respectfully requested.

II. Objection to the Claims

Claims 4-10 have been objected to as being dependent upon a rejected base claim. The Examiner suggests that the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claim 1 to include the limitations of claim 4. Accordingly, withdrawal of this objection is respectfully requested.

III. Rejection of Claims Under 35 U.S.C. 102

Claims 1, 2, 12, 13 and 14 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kool et al. (US Patent 5,683,874). The Examiner suggests that this patent discloses an oligonucleotide that is reverse complementary to nucleobases 388 through 398 of SEQ ID NO: 3 of the instant invention with 92% similarity and that this compound, absent evidence to the contrary, would inherently function as claimed. Applicants respectfully traverse this rejection.

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At the outset, Applicants have amended the claims as discussed above to recite the limitation of claim 4, having at least one modified internucleoside linkage. Support for this amendment is found throughout the specification as filed.

Kool et al. disclose a single compound that is reverse complementary to a part of the sequence of SEQ ID NO: 3, namely nucleobases 388 to 398, with only one mismatch. However, nowhere does this patent teach or suggest modified antisense compounds as now claimed that are capable of specifically hybridizing with and inhibiting expression of macrophage inflammatory protein 3-alpha. In order to anticipate an invention the cited reference must teach each and every limitation of the claims (MPEP 2131). This reference fails to teach the limitations of the claims as amended and thus cannot anticipate the instant invention. Withdrawal of this rejection is respectfully requested.

Claims 1, 2, 12, 13 and 14 have been rejected under 35 U.S.C. 102(e) as being anticipated by Landsdorp et al. (US Patent 6,514,693). The Examiner suggests that this patent discloses a hybridization probe that is reverse complementary to nucleobases 365 through 377 of SEQ ID NO: 3 of the instant invention with 92% similarity and that this compound, absent evidence to the contrary,

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would inherently function as claimed. Applicants respectfully traverse this rejection.

As discussed *supra*, Applicants have amended the claims as discussed above to recite the limitation of claim 4, having at least one modified internucleoside linkage. Landsdorp et al. disclose a single compound that is reverse complementary to a part of the sequence of SEQ ID NO: 3, namely nucleobases 365 to 376, with only one mismatch. However, nowhere does this patent teach or suggest modified antisense compounds as now claimed that are capable of specifically hybridizing with and inhibiting expression of macrophage inflammatory protein 3- α . In order to anticipate an invention the cited reference must teach each and every limitation of the claims (MPEP 2131). This reference fails to teach the limitations of the claims as amended and thus cannot anticipate the instant invention. Withdrawal of this rejection is respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

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favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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